

## REMARKS

Claims 1-32 are pending in the application. Claims 1-32 stand rejected. Claims 1-4, 9, 17-20 and 25 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Ubillos (US 6,486,896) in view of Sciammarella et al. (US 5,983,369), and further in view of Dempski et al. (US 6,564,209). Claims 10-16 and 26-32 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Ubillos (US 6,486,896) in view of Sciammarella et al. (US 5,983,369), and further in view of Dempski et al. (US 6,564,209) and Morris et al. (US 6,097,389).

Applicants respectfully request reconsideration in view of the foregoing amendments and the remarks hereinbelow.

### **Rejection of Claims under 35 U.S.C. 103:**

#### **1. Claims 1 –4, 9, 17 – 20 and 25:**

Claims 1 – 4, 9, 17-20 and 25 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Ubillos in view of Sciammarella et al and further in view of Dempski et al.

#### **a. The Rejection**

The Examiner's grounds for rejecting claim 1 are as follows:

*As per claim 1 Ubillos teaches a graphical user interface adapted to browse and retrieve picture stored in a digital image; database, said graphical user interface comprising (col. 2, lines 8-16). The Examiner infers a database that stores a series of digital images to be a broad range a data.*

*A metadata decoder adapted to decode metadata stored in digital image files; a first display level constructed with the aid of decoded metadata, said first display level comprising a first metaphor representing the span of time over which picture stored in said database were captured (col. 2, lines 23-38) and at least a second display level constructed with the aid of decoded metadata and linked to said first display level (col. 2, lines 30-38).*

*The Examiner considers the display that is displayed once a user has zoomed in to be a second display level.*

*However, Ubillos fails to teach the interface further comprises: a plurality of first icons placed on said first metaphor representing predefined temporal intervals, said first icons being proportionately sized to correspond to the number of pictures captured during a predefined temporal interval. The display of the second level is triggered by activating one of said first icons, said second display level comprising a second metaphor, and second icons placed on said second metaphor for grouping the pictures*

*represented by the activated first icons, said second icons being proportionately sized to correspond to the number of pictures captured for each grouping.*

*Sciammarella et al. teaches an interface comprising: plurality of icons that represent different interval of the database, the size of the icon is corresponding to value (col. 3, lines 13-19); and each icon allows a user to "zoom in" for a closer examination of the data. It would have been obvious to an artisan at the time of the invention to include Sciammarella et al.'s interface in order to allow the users to access the data directly.*

Dempski et al. is offered in addition to this two-way combination for the following reasons

*Both Ubillos and Sciammarella fail to teach the icons are proportionally sized to correspond to the number of pictures captured for each grouping. Dempski et al. teaches showing number of documents by proportionally increasing or decreasing the size of the representative object (Col. 17, lines 20-48).*

*It would have been obvious to combine Dempski's teaching with the method of Sciammarella et al.'s teaching and Ubillos to convey relevant data to the user visually."*

Thus, the Office Action rejection of claim 1 generally comprises five parts, 1.) a verbatim restatement of the purported teachings of Ubillos and Sciammarella from the Office Action of January 28, 2004; 2.) a new motivation for combining these references; 3.) a concession that the combination of Ubillos and Sciammarella do not teach or suggest icons that are proportionately sized to correspond to a number of pictures for a grouping; 4.) the introduction of a new reference, Dempski et al. which allegedly "teaches showing the number of documents by proportionally increasing the size of the representative object; and 5.) a motivation to combine the references.

## **2. Response.**

Turning now to each identified part of the rejection, the applicants state as follows:

### ***1. Part 1 of the Office Action Fails for the reasons stated in the Appeal Brief.***

The Appeal Brief of July 2, 2004, incorporated herein by reference, establishes at least the following deficiencies in the combination of Ubillos and Sciammarella et al.

1. *The combination of Ubillos and Sciammarella et al. does not teach or suggest, a first metaphor representing a period of time over which pictures stored in [a] database were captured as the timeline of Ubillos receives video content selectively assembled by a user, and is sized in proportion to the duration of the assembled video content.*
2. *The combination of Ubillos and Sciammarella et al. does not teach or suggest, a first display level comprising a first metaphor representing the span of time over which pictures were stored in the database, and a plurality of first icons placed on said first metaphor representing predefined temporal intervals, as the combination of the references does not teach or suggest icons that represent predefined temporal intervals.*
3. *The combination of Ubillos and Sciammarella does not teach or suggest a plurality of first icons placed on said first metaphor representing predefined temporal intervals said first icons being proportionally sized to correspond to the number of pictures in the predefined time interval as the references taken as a whole do not show a first icon that is sized to correspond to a number of pictures captured during the predefined interval.*
4. *The combination of Ubillos and Sciammarella et al. also does not teach or suggest a plurality of first icons placed on said first metaphor representing predefined temporal intervals said first icons being proportionally sized to correspond to the number of pictures in the predefined time interval as Ubillos shows only a manually resizable slide controller that always indicates one instant of a video image regardless of size and Sciammarella et al. shows icons sized based upon a relevancy determination.*
5. *The combination of Ubillos and Sciammarella et al. does not teach or suggest at least a second display level constructed with the aid of decoded metadata and linked to said first display level and triggered by activating one of said first icons, said second display level comprising a second metaphor and second icons.*
6. *The combination of Ubillos and Sciammarella et al. does not teach or suggest a second display triggered by activating first icons for the reason that Sciammarella et al. shows only icons that are activatable to access individual documents.*
7. *Taken as a whole, combination of Ubillos and Sciammarella et al. further fails to teach or suggest second icons that are proportionately sized corresponding to the number of pictures captured for each grouping.*

The Applicants respectfully submit that each of these deficiencies is well documented in the Appeal Brief however, only one of these deficiencies, deficiency 7, has been discussed by the Examiner in the Office Action of October 5, 2004.

**2. *The new motivation to combine Ubillos and Sciammarella fails.***

The Office Action of October 5, 2004, concedes that neither the Ubillos nor Sciammarella et al. patents individually describe the limitations of claim 1 (see Office Action of January 28, 2004 at Pg. 4). However, the Applicants respectfully submit that the Examiner has failed to establish evidence of a motivation for such a combination.

Neither reference suggests the need for or the desirability of a combination to meet the limitations of Claim 1. The Examiner contends that there is a motivation to combine these references "allow users to access the data directly". However, the Applicants respectfully submit that such a vague and general motivation could be offered in support of any combination of any two database patents and does not comply with the requirements of the law as is discussed in the MPEP at Section 2143.01 entitled Suggestion or Motivation To Modify the References:

*"There are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art." In re Rouffet, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998) (The combination of the references taught every element of the claimed invention, however without a motivation to combine, a rejection based on a prima facie case of obvious was held improper.). The level of skill in the art cannot be relied upon to provide the suggestion to combine references. Al-Site Corp. v. VSI Int'l Inc., 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999).*

*"In determining the propriety of the Patent Office case for obviousness in the first instance, it is necessary to ascertain whether or not the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the reference before him to make the proposed substitution, combination, or other modification." In re Linter, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).*

*Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or*

*in the knowledge generally available to one of ordinary skill in the art. "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also In re Lee, 277 F.3d 1338, 1342-44, 61 USPQ2d 1430, 1433-34 (Fed. Cir. 2002) (discussing the importance of relying on objective evidence and making specific factual findings with respect to the motivation to combine references); In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).*

Notably, no showing has been made of any teaching, suggestion or motivation for the combination in the nature of the problem to be solved in the references themselves or in the knowledge generally available to one of ordinary skill in the art. Accordingly, the purported motivation for this combination appears to constitute the impermissible use of hindsight.

### **3. The concession.**

The Examiner concedes the existence of a deficiency of the combination of Ubillos and Sciammarella that appears to be related to the seventh deficiency identified in the Appeal Brief of July 2, 2004, namely that the combination does not teach or suggest icons that are proportionally sized to correspond to the number of pictures captured for each grouping.

### **4. Dempski does not teach proportionally sizing an icon based upon the number of documents with a grouping.**

The only portion of Dempski et al that is said to provide such a teaching is col. 17, lines 20 – 48. These lines state as follows:

*FIG. 15 illustrates a Gantt chart 1500 for Mike Ethelston. The chart shows the user that in 1998 Ethelston posted articles to the KX on Shared Services 1502 and Financial Management 1504.*

#### *Client Charts:*

*After searching for and selecting a client (i.e. the client's name is displayed on the left side above the main window), click the "Chart" button to the left of the main window, or select View.vertline.Chart Data from the Menu bar.*

*The knowledge management tool will display a KX Profile for the selected client. The chart illustrates the KX postings relative to that client in various KX libraries.*

*For example, the chart 1600 for Microsoft, illustrated in FIG. 16, shows that people began posting client documents about Microsoft*

*on the KX in 1996 as well as the point in time when information on a specific topic was posted about Microsoft.*

#### *Topic Charts*

*After searching for and selecting a topic (i.e. the topic is displayed on the left side above the main window), click the "Chart" button to the right of the main window, or select View.vertline.Chart Data from the Menu bar.*

What is shown in Figs. 15 and 16 is a chart having a list of topic areas along a vertical axis and a range of chronological periods along a horizontal axis. A plurality of time bars is presented on each of these charts. The time bars are sized to indicate a range of time in which a particular author published a first and a last paper on that topic. The purpose of such a chart is to show when the author worked on that topic. The size of each time bar does not indicate how many papers were published in that range of time. The author could publish 100 papers on a first topic on the same day and the size of the bar would be very small, while publishing only two papers over the course of 10 years on another topic and the bar would be comparatively much larger. Thus, Dempski et al. fails to teach or suggest at col. 17, lines 20-40 an icon that is sized to correspond to a number of pictures captured within a predefined temporal interval and instead shows an icon that is variably sized according to a temporal interval over which a plurality of publications have been made. In this regard, Dempski et al. teaches away from what is claimed in claim 1.

#### ***5. The Examiner has failed to provide an adequate motivation for the combination of Ubillos, Sciammarella et al. and Dempski et al.***

Not one of these references suggests the need for or the desirability of a combination to meet the limitations of Claim 1. The only rationale for this combination that has been provided is that "it would be obvious to an artisan at the time of the invention to include Dempski's teaching with method of Sciammarella's teaching and Ubillos in order to convey relevant data to the user visually." (Page 4, Office Action dated October, 2004) The Applicants respectfully submit that such a vague and general motivation could be offered in support of any combination of any number of graphical interface patents does not

appear to comply with the requirements of the law as is discussed in the MPEP at Section 2143.01 entitled Suggestion or Motivation To Modify the References:

*"There are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art." In re Rouffet, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998) (The combination of the references taught every element of the claimed invention, however without a motivation to combine, a rejection based on a prima facie case of obvious was held improper.). The level of skill in the art cannot be relied upon to provide the suggestion to combine references. Al-Site Corp. v. VSI Int'l Inc., 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999).*

*"In determining the propriety of the Patent Office case for obviousness in the first instance, it is necessary to ascertain whether or not the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the reference before him to make the proposed substitution, combination, or other modification." In re Linter, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).*

*Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also In re Lee, 277 F.3d 1338, 1342-44, 61 USPQ2d 1430, 1433-34 (Fed. Cir. 2002) (discussing the importance of relying on objective evidence and making specific factual findings with respect to the motivation to combine references); In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).*

Notably, no showing has been made of any teaching, suggestion or motivation for the combination in the nature of the problem to be solved, in the references themselves or in the knowledge generally available to one of ordinary skill in the art. Specifically, Ubillos describes a video editor with a principal display level comprising a timeline having a manual controlled slide bar allowing selection of an instant of edited video. Sciammarella et al. describes a keyword-searching program that returns keyword results in a listing with icons sized in accordance with relevancy. Dempski et al. describes a database system that

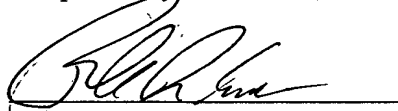
shows one embodiment where icons are sized in accordance with the separation in time of the work published by an author. These are not inherently suggestive of a need for combination nor are they even inherently compatible except through hindsight.

Accordingly, for the reasons stated above, claim 1 and all claims that depend upon claim 1 are believed to be in a condition for allowance as the Appeal Brief has established that there are many deficiencies in the combination of Ubillos and Sciammarella et al. Further claim 1 and all claims that depend from claim 1 are believed to be in a condition for allowance as the combination of Dempski et al. with Ubillos and Sciammarella et al does not address any of these deficiencies, including the deficiency that the Examiner has conceded exists in the Ubillos and Sciammarella et al. combination. Finally, claim 1 and all claims that depend upon claim 1 are believed to be in a condition for allowance as there is no proper motivation to combine Dempski et al. with Ubillos and Sciammarella et al.

Further, claim 17 claims a method for producing a graphical user interface and is believed to be allowable for the same reasons stated with respect to claim 1, further, all claims that depend from claim 17 are also believed to be allowable for the same reasons as claim 17.

It is respectfully submitted, therefore, that in view of the above amendments and remarks, that this application is now in condition for allowance, prompt notice of which is earnestly solicited.

Respectfully submitted,



Attorney for Applicant(s)  
Registration No. 40,802

Roland R. Schindler II/jrk  
Rochester, NY 14650  
Telephone: 585-588-2736  
Facsimile: 585-477-1148